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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Stern et al.

Applicants: Randolph A. Stern and Michael N. Byles
Serial No.: 09/558,329
Confirmation No.: 9722
Filed: April 25, 2000
Examiner: Cheryl Juska
Group Art Unit: 1771
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith

Cincinnati, OH 45202

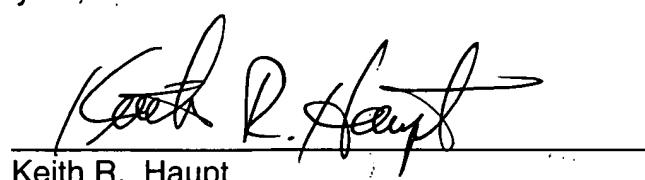
May 14, 2004

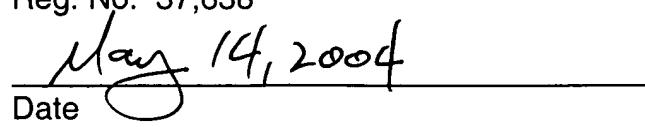
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REPLY BRIEF

This Reply Brief under 37 C.F.R. § 1.193(b)(1) is in response to the Examiner's Answer dated March 15, 2004 in the above-captioned appeal. This Reply Brief is filed to focus on specific issues raised by the Examiner's Answer of March 15, 2004 and issues related thereto so that the Board may have a more complete picture of the Examiner's rejections and prosecution of this reissue application.¹

¹ Appellants submit that the initial prosecution of this re-issue application, the subsequent appeal and associated briefs to the Board, the prosecution before the Examiner after the remand from the Board and the reinstatement of the appeal and associated briefs to the Board have largely addressed the issues. Appellants will not belabor that same material here, and instead incorporate and reaffirm their analysis and remarks previously presented to the Board in support of the reversal of the Examiner's rejections.

I. Prior Art Rejections

A. Prior Art Rejections Fail to Address Key Claim Limitation

The crux of the prior art rejections in this Appeal is the Examiner's failure to properly interpret the term "yarn face" in the claims and failure to even acknowledge, let alone lend patentable weight to, such term in the claims.

The term "yarn face" is explicitly included in each and every claim in this application, each of which is in appeal before this Board. It should go without noting that black letter patent law requires that every claim limitation is meaningful and must be given effect. In re Angstadt, 190 USPQ 214, 217 (CCPA 1976). Lantech, Inc. v. Keip Machine Co., 33 F.3d 542, 31 USPQ2d 1666, (Fec. Cir. 1994) (All limitations in a claim must be considered meaningful.); Ethicon Endo Surgery, Inc. v. United States Surgical Corp., 93 F.3d 1572, 40 USPQ2d (Fed. Circ. 1996). Nevertheless, the Examiner has presented approximately eight pages of prior art rejections detailing eleven different rejections and applying six different prior art references (not to mention the added Official Notice) in the Answer dated March 15, 2004. In all of that analysis, the rejections do not include any mention whatsoever of the "yarn face" limitation.

Appellants respectfully assert that the Board's decision with respect to the propriety of the prior art rejections is simple and straightforward. The rejections fail to address an explicit claim limitation ("yarn face") nor do they demonstrate where such a feature is shown in the prior art. Therefore, the rejections must be reversed as failing to present a *prima facie* case for either obviousness or anticipation.

B. Proper Meaning of “Yarn Face” is in the ‘757 Patent Specification

The term “yarn face” is not one which is readily understood in and of itself without resort to the specification. In this case, the ‘757 patent specification serves as a dictionary for the term “yarn face” because it expressly defines the claim term. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). It is black letter patent law that a patentee can “choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning.” Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, 70 USPQ2d 1851, 1854 (Fed. Cir. 2001).

Appellants, in their ‘757 patent specification, have clearly defined the claim term “yarn face”. That definition is dispositive of the matter, as it is error to “overlook[] the explicit definitions of the claim term provided in the specification”. Jack Guttman, Inc. v. Kopykake Enterprises, Inc., 64 USPQ2d 1302, 1308 (Fed. Cir. 2002). Moreover, no other extrinsic evidence casts doubt on that definition. Id. at 1307.

As explained in the specification of the ‘757 patent which forms the basis for this reissue application, a “yarn face” is constructed of yarn segments that cooperate to define a face of fabric above a surface of the web. The “yarn faces” are effectively continuous such that the web is not exposed. (‘757 Patent, Column 2, lines 52-65).

The purpose of patent claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. A claim, and specifically a term such as “yarn face” in the claims, cannot be interpreted properly without going beyond the claim itself as is required. Autogiro Co. of America v. United States, 384 F. 2d. 391, 397, 155 USPQ 697, 701 (Ct. Cl. 1967). Proper claim construction does not

limit nor broaden the claims, but defines them as a matter of law as well as the invention to be patented. Claims are always construed in light of the specification of which they form a part. Netword LLC v. Central Corp., 58 USPQ 2d 1076, 1079 (Fed. Cir. 2001), citing Slimfold Mnfg. Co. v. Kinkead Industries, Inc., 810 F. 2d. 1113, 1118, 1 USPQ2d, 1563, 1566 (Fed. Cir. 1987). The '757 patent presents a description of the technology and subject matter of Appellants' invention while the claims point out with particularity the subject matter that is to be patented. The claims as such do not have meaning removed from the context from which they arose. The claims are directed to the invention that is described in the '757 patent. Renishaw plc v. Marposs Societa' per Azioni, 158 F. 3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("[T]he interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelope with the claim.")

As such Appellants hereby reassert that the term "yarn face" as properly interpreted includes the definition provided in the '757 patent. Moreover, such a description that the "yarn face" is formed from yarn segments that provide an effectively continuous surface is both definite and provides an appropriate standard for ascertaining the requisite degree of continuity as will be readily understood by one of ordinary skill in the art. The yarn face is comprised of yarn segments that are effectively continuous to a degree that the web is not exposed. The fact that such a definition and associated claim language is not as precise as the Examiner would prefer does not render the claim invalid under a proper application of the law. The '757 patent unambiguously provides a standard for measuring the degree of continuity (i.e., such

that the web is not exposed). One of ordinary skill in the art would readily comprehend such a standard. See Exxon Research and Engineering Co. vs. United States, 60 USPQ2d 1272, 1280 (Fed. Cir. 2001); Seattle Box Co. v. Industrial Crating & Packaging, Inc., 731 F. 2d. 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The '757 patent teaches that the web should not be exposed through the yarn face to provide a soft, comfortable layer against a patient's skin. Therefore, when properly interpreted, the claims and the term yarn face have the meaning as provided for in the '757 patent.

Once interpreted in this manner, the basis for maintaining the prior art rejections with respect to each of the identified prior art references in the Examiner's Answer evaporates. As such, when the claims are properly interpreted to include the "yarn face" that is effectively continuous so that the underlying felt web is not exposed as validated in the '757 patent specification, the Examiner's basis for maintaining the prior art rejections crumbles.

C. Examiner Previously Acknowledged the Yarn Face Definition, But Refused to Permit Amendment of the Claims Accordingly

The Examiner's Answer states that there are no un-entered amendments to the claims. While that statement may be technically accurate, it is not correct or fair. As previously explained, the specification clearly defines the term "yarn face" as requiring that it be a fabric face of yarns that are spaced closely enough to be "effectively continuous" such that a felt web on which the face is formed is not generally exposed at the face. During a personal interview with the Examiner on December 21,

2000, Appellants' attorney was of the view, and understood the Examiner to agree, that if the term "yarn face" was properly construed to be "effectively continuous", the claims would distinguish over the art cited by Examiner. Appellants previously offered to amend the claims according to indications in the Final Office Action that such a feature would distinguish the prior art (see Request to Withdraw Finality of Office Action dated July 19, 2001), so as to make explicit what Appellants submit is meant by the claim term "yarn face".

In an unexpected and sudden turnabout, Examiner refused to withdraw the finality of the Office Action to allow such an Amendment and argued that the representations she previously made were not going to be honored. Indeed, in the comments attached to the Advisory Action mailed August 14, 2001, it is clear that the art relied upon by Examiner does not show a yarn face which is effectively continuous (which is what Appellants contend is the proper construction of the claim term in any event), yet Examiner indicated she would not enter an After Final Amendment to make explicit what Appellants believe is implicit in the term "yarn face" and which the Examiner acknowledges in the Final Office Action is a patentable distinction and would result in allowability of claims over the art.

Therefore, technically there are no outstanding or un-entered amendments. On the other hand, Appellants submit such an amendment is unnecessary, given proper construction of the term "yarn face". They do, however, remain willing to state that definition in the claims as it is believed to already be part of the claim when properly interpreted.

II. **Section 112 Enablement Rejection**

A. **Hydrophobic/Hydrophilic Features are Not Critical or Essential to the Claimed Invention**

The enablement rejection of Claims 30-87 is based solely upon the Examiner's assertion that the hydrophobic/hydrophilic properties of the web are critical and since they are not cited in the rejected claims, that enablement is lacking. However, the Examiner fails to consider the entire disclosure of the '757 patent. Moreover, the Examiner focuses on the hydrophobic/hydrophilic nature of the web as being the core concept and critical element of Appellants' invention. Such emphasis on the hydrophobic/hydrophilic features is erroneous, and the '757 patent disclosure in its entirety supports Appellants' position.

Specifically, in the Description of Prior Art section of the '757 patent, Appellant's own prior product is identified under the trademark COMPLY® as "an integral web fabric that provides a hydrophobic upper surface and a hydrophilic lower surface in wicking communication with the upper surface." (Column 1, lines 30-32.) As such Appellant has admitted that felt webs having both hydrophobic and hydrophilic components are known in the art prior to the invention of Claims 30-87. Therefore, how could such features be critical/essential to the invention? The answer is simply that the hydrophobic/hydrophilic properties of the felt web are not critical or essential and Appellant's invention provides other patentably important features.

Disclosure in the '757 patent, when considered in its entirety, clearly shows that the hydrophilic/hydrophobic features of the web are not critical or essential to the invention. As described in the Background of the Invention of the '757 patent,

the manufacture of incontinent pads and similar products presents significant cost concerns especially due to the need to separately manufacture a facing fabric and a felt layer and to then apply a quilting process to hold those layers together. (Col. 1, lines 36-40). The focus of Appellant's invention is to provide "an improved fluid-retaining fabric such as may be substituted for the facing fabric and felt of the prior incontinent pads and which reduces the cost of manufacture thereof." (Column 1, lines 44-47) Therefore, manufacturing considerations and the provision of an appropriate facing fabric in a fluid retaining product such as an incontinent pad or the like are the critical and essential features/elements of Appellant's invention. As such, the yarn faces, which are produced by the stitch bonded yarns extending through the felt web as presented throughout the entire disclosure of the '757 patent is the focus of Appellant's invention.

Analysis of the entire disclosure of the '757 patent and not solely the preferred embodiments or specific examples of the felt webs to which the stitch bonding is applied to produce yarn faces clearly demonstrates this fact. The Examiner's assertions and arguments to the contrary myopically focus on only specific parts of the disclosure. In support of those arguments, the Examiner has judiciously picked and extracted portions of the disclosure of the '757 patent which relate to one embodiment of a felt web which happens to include hydrophobic/hydrophilic properties. However, an analysis of the entire '757 patent as is proper under an enablement inquiry, reveals that Claims 30-87 are in fact compliant with 35 U.S.C. §112. Features which are merely preferred and are not considered critical are not required in the claims for proper enablement.

The '757 patent provides more than adequate guidance for one skilled in the art to practice the invention of Claims 30-87 without undue experimentation. Proper analysis of the patentable features of Claims 30-87 reveals that those claims are commensurate in scope with disclosure in the '757 patent. The Examiner would limit Appellant's claims to only the specific materials/features disclosed in the '757 patent. However, to require Appellants to include the hydrophobic/hydrophilic features in the claims even though such features are merely preferred, is clearly contrary to established law. See 3M Innovative Properties Co. v. Avery Dennison Corp., 350 F.3d 1365, 69 USPQ2d 1050 (Fed. Cir. 2003).

The enablement requirement does not require that the patent disclose every embodiment of the claim but the enablement requirement does state that a broad claim can be enabled by the disclosure of a single embodiment. See Cross v. Iizuka, 224 USPQ 739, 748 (Fed. Cir. 1985); Gould v. Mossinghoff, 229 USPQ 21, 14 (D.D.C. 1985). Further, a claim is not invalid for lack of enablement simply because it reads not only on the disclosed embodiment of the invention, but also on other embodiments which may or may not be disclosed in the specification. See Gould v. Mossinghoff, 219 USPQ 393, 396 (D.C. Cir. 1983) aff'd 3 USPQ2d 1302 (Fed. Cir. 1987).

The Board has also acknowledged that claims which are broader than the specific embodiments of the invention disclosed in the specification are enabling and that in mechanical cases and other predictable arts, broad claims may cover more than the specific embodiment disclosed in the specification. Ex Parte Alan J. Knobbe et al., Appeal No. 92-1191, page 4 (PTO Brd. Pat. App. & Int., 1992) citing In Re Vickers, 61 USPQ 122 (CCPA 1944) and In Re Newton, 163 USPQ 34 (CCPA 1969).

B. Examiner Misapplies Enablement Test

The law of enablement remains clear and straight forward and continues to be enunciated by the Court of Appeals for the Federal Circuit consistent with Appellants' and not the Examiner's application of it. Specifically, the Federal Circuit recently reiterated that the enablement requirement is satisfied if one skilled in the art, after reading the disclosure, could practice the invention claimed without undue experimentation. Chiron Corp. v. Genentech, Inc., 2004 U.S. App. Lexis 5830 (Fed. Cir. 2004). The Federal Circuit reiterated that undue experimentation is a matter of degree with respect to the enablement requirement. The fact that some experimentation may be required does not preclude enablement. The amount of experimentation must not be unduly extensive. PPG Industries, Inc. v. Guardian Industry, Corp., 75 F.3d 1558, 1564 (Fed. Cir. 1996) (quoting Atlas Powder Co. v. E.I. DuPont DeMemours & Co., 750 F.2d 1569, 1576 (Fed. Cir. 1984)).

The Federal Circuit reiterated the analysis required by the Board through the In re Wands criteria. Appellants previously set forth a detailed and thorough analysis of each of the Wands factors to clearly demonstrate that undue experimentation is not required for claim 30-87. Nevertheless, the Examiner's attempt to finally address the In re Wands factors is confusing and misguided. Specifically, with respect to numerous Wands factors (including the breadth of the claims, the quantity of experimentation and direction/guidance presented in the specification), the Examiner relies upon analysis of a web consisting of polytetrafluoroethylene (PTFE) fibers in an effort to show that undue experimentation may be necessary for enablement of Appellants' claims 30-87. However, by doing so the Examiner has

selected one specific felt web material which is neither disclosed nor taught in Appellants' specification in an attempt to assert that Appellants' specification does not enable one of ordinary skill in the art how to practice the invention of claims 30-87 for utilizing a PTFE felt web. The Examiner has chosen a particular material and, since that material is neither taught nor disclosed in Appellants' specification, the Examiner alleges that undue experimentation would be required to produce a felt web of PTFE. The logic of this assertion escapes Appellants.

More appropriately, proper analysis of the Wands factors states that the specification itself does not need to describe how to make and use every possible variant of the claimed invention because one skilled in the art with the benefit of routine experimentation can fill gaps, interpret between embodiments and, perhaps, even extrapolate beyond the disclosed embodiments, particularly with highly predictable technologies, such as those involved here. See Chiron Corp. v. Genentech, Inc., citing AK Steel Corp. v. Sollac, 344 F.3d 1234, 1244 (Fed. Cir. 2003).

C. Inconsistent Rejections

The Examiner's rejections as presented in the Answer are inconsistent and self-serving. Appellants note that the Examiner relies upon the Gentry Gallery, Inc. v. The Berkline Corp., 45 USPQ2d 1498 (Fed. Cir. 1998) with respect to the proposition that Appellants' claims are limited by the specific embodiments disclosed in the specification (namely, hydrophobic/hydrophilic properties). Unfortunately, the Examiner does not realize that the § 112, first paragraph rejection at issue is an enablement matter and not a written description rejection. The Gentry Gallery case,

and the Court's analysis therein, is specifically directed to the written description requirement of § 112, paragraph 1.

Additionally, on pg. 5, ¶ 1 of the rejections in the Answer of March 15, 2004, the Examiner states that "due to lack of an explicit definition in the specification, for the purposes of examination, Appellants' claim term "felt web" is interpreted in a broad sense as any non-woven, web, or batting comprising discontinuous or staple fibers." Therefore, the Examiner clearly states that the term "felt web" as used in the claims is being interpreted in a broad sense to include any non-woven, web or batting material have discontinuous or staple fibers. If the term "felt web" is being interpreted as such by the Examiner, why doesn't the Examiner rely upon her own definition of "felt web" for purposes of the § 112 enablement analysis? Anyone of ordinary skill in this art readily recognizes a vast array of materials that satisfy this definition of a felt web. As such, no experimentation would be required at all to provide a felt web as recited in the claims based on such a definition. Simply put, the Examiner chooses a broad definition of "felt web" in one instance and reverts to alleging that the "felt web" must be hydrophobic/hydrophilic for the § 112 enablement analysis. Appellants respectfully assert that the Examiner is picking and choosing how to interpret the claims to best suit the Examiner's motivation to reject Appellants' claims, rather than for proper analysis within the statutory guidelines which define the patent process.

In that regard, Appellants fully agree with the Examiner's definition of "felt web" as utilized in the specification and claims. In other words, the Examiner's definition of "felt web" has a broad meaning as any non-woven, web or batting comprising discontinuous or staple fibers. As such, the term "felt web" in the '757

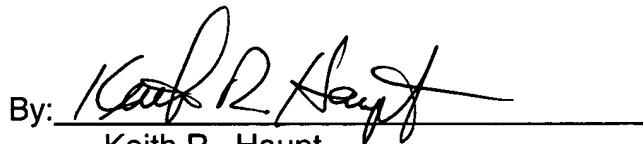
patent specification and claims 30-87 carries the same meaning. Any one of ordinary skill in this art would readily recognize innumerable materials which satisfy this felt web definition. As such, undue experimentation is clearly avoided and implementation of a felt web into claims 30-87 is readily achieved. Any non-woven, web or batting having discontinuous or stable fibers would satisfy the practice of claims 30-87. The claims are clearly enabled according to the Examiner's own definition of "felt web" which does not include any of the allegedly critical or essential features.

III. Conclusion

For the reasons stated herein and previously, Appellants respectfully urge the Board to reverse the rejections of claims 1-87.

Respectfully submitted,

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